Appl. No.   :   **10/065,120**
Filed   :   **September 18, 2002**

REMARKS

Reconsideration and allowance of the above-referenced application is respectfully requested.

A Terminal Disclaimer is concurrently filed, disclaiming the term that extends beyond the parent patent. This does not constitute acquiescence in the view that the claims are obvious over the previous patent, but rather is being filed in view of the fact that such a Terminal Disclaimer will have no effect on the patent term.

Claim 36 is cancelled in order to obviate the statutory type double patenting rejections thereto.

Claims 1-35 stand rejected under 35 U.S.C. 102 as allegedly being unpatentable over Stewart. This contention is respectfully traversed, and it is respectfully suggested that the rejection does not meet the Patent Office's burden of providing a prima facie showing of unpatentability.

To summarize the reasons which are given below, Stewart does teach a special mode in which locations can not be transmitted without the user being alerted. Stewart also teaches a mode in which the system refuses to provide a location signal. However,

> Stewart does not teach any mode that "prevents said position detection module from determining its position", as required by claim 1.

In fact, in all of Stewart modes, all that is blocked is the communication of the signal indicative of position, that has been determined. Nothing in Stewart teaches preventing the GPS module from determining the position, but Stewart does teach preventing that signal from being reported.

-12-

Appl. No.   :   **10/065,120**
Filed   :   **September 18, 2002**

The rejection is based on, at least partly, the manual override switch 42. Manual override switch 42 enables entering a special override mode. Column 9 describes the override mode. Specifically, column 9, line 62 begins a description of a background operation in which the portable phone's location can be obtained without disturbing the user. In addition, another automatic update of location can be sent to the caller; again without disturbing the user.

Column 9 describes that the bypass which can be used to insure "that no locations are transmitted <u>without the user being alerted</u>..." (emphasis added, column 9, line 3. Bypass which can also be used to allow the user to "completely deactivate background operation so that received incoming calls <u>carrying only a location request code</u> will be automatically disconnected without GPS location locator providing a location signal". (Emphasis added, column 9, lines 5-10.) Note that the implication is that the GPS location detector could provide a location signal. Therefore, it is clear that the GPS location detector, or the position detecting module, is still <u>determining</u> its position, even during the operation of the bypass switch, since it COULD provide the position. It is therefore clear that the bypass which does not "prevent said position detection module from <u>determining</u> its position", it at most prevents the position detection module from <u>reporting</u> its position.

Therefore, it is clear that claim 1, which requires that the override control prevents the position detection module from determining its position, is not in anyway taught or suggested by Stewart.

Claim 3 should be allowable for similar reasons, since it states that in the privacy enhanced mode, the position of the cellular phone "cannot be automatically detected by

-13-

Appl. No.   :   **10/065,120**
Filed   :   **September 18, 2002**

said automatic position sensing device". Therefore, claim 3 should be allowable along

with the claims which depend therefrom.

Claims 4-6 define testing the privacy of the cellular phone. This is not taught or

suggested by Stewart, and hence each of these claims should be additionally allowable.

Stewart does not teach a system which blocks reporting the information "in any mode of said electronic device".

Claim 9 recites a different feature, specifically that the override control, in

combination with the electronic device, produces a signal "that prevents said position

detection module from reporting any information, in any mode of said electronic device,

until manually de-activated". This is not in any way taught or suggested by Stewart, as

should be apparent from the description above. The bypass switch can do two things.

First, it can insure that no locations are transmitted without an alert. It does not prevent

transmitting location information, but only prevents silent transmission of the location

information. This is described column 9, lines 1-5. From this, it logically follows that

locations can be transmitted with an alert in Stewart. That is, in this specific mode of

operation (the specific mode being, with an alert), transmission can be enabled to

report information in a specified mode.

The second mode described beginning at line 5 enables the user to deactivate

background operation, so that received calls that only have a location request code are

disconnected. Again, it logically follows from the word "only", however, that when the

received codes calls include more than just a location request code, that is when the

calls include both location request code and also a requ st to talk to the user, then they

are accepted, and the system does report the location in that mode. Another words, in

-14-

Appl. No.   :   **10/065,120**
Filed   :   **September 18, 2002**

this mode of operation, only location-only calls are rejected. If the call is both location and talk, then it is not rejected.

Both of these would obviously be unacceptable from the point in view of privacy. If the user wants location privacy, they would obviously not find it acceptable to report their position just because the call came in <u>along with</u> a request to talk to the user. In addition, the user would not find their privacy to be adequately protected if their position was recorded even if it was along with an alert. Clearly this does not prevent the position detection module from reporting any information <u>in any mode of</u> the electronic device, as required by claim 9.

Claim 10 has been amended in a similar way, to recite preventing reporting any information in any mode of operation and hence claim 10 should be similarly allowable along with the claims which depend therefrom.

Claim 11 should be allowable for reasons stated above with respect to claims 1 and 3, since it specifies that the override control prevents the module from determining the detected position.

Claim 20 has been amended in a similar way and should be allowable for similar reasons along with the claims which depend therefrom.

Similarly, claim 28 has been amended similarly to recite preventing reporting of information in any mode of operation of the cellular phone and should similarly be allowable.

Claim 31 should be allowable for similar reasons, as it recites preventing "any automatic reporting of said position". As discussed above, Stewart does allow certain reporting of information even when in the override stat .

-15-

Appl. No.   :   **10/065,120**
Filed   :   **September 18, 2002**

Therefore, for these reasons, it is respectfully sugg st d that claims 1-35 should be allowable.

Claims 1-35 stand alternatively rejected as being unpatentable over Seiple in view of Ohyama. This contention is further respectfully traversed.

<u>If Seiple were modified by the specified teaching in Ohyama, it would destroy the inherent functionality of Seiple.</u>

First of all, if Seiple were modified in the specified way suggested by Ohyama, then it would be possible to enter a PowerSave mode placing the GPS receiver to sleep. By doing this, the GPS receiver would no longer know its position. It is well known the GPS receivers can take minutes, sometimes many minutes, to calculate their position from the incoming arrange signals. Therefore, if Seiple were modified using the teaching of mode. the GPS device would not always know its location. (Incidentally, this is supported by the Examiner's citation of 'Herring which explains this phenomenon at the top of column 3).

Seiple is a personal emergency location system. Once a user goes overboard, they want to know their location so that the boat can pick them up. The device would simply not be usable if the user had to take it out of sleep mode and only then find their location. This could mean many minutes of delay until the user could be located. In an emergency situation, this would simply not be acceptable. Rather, in an emergency situation, the device needs to be in ready mode <u>at all times.</u>

The rejection alleges that there is an override control described column 4, lines 60-65. Admittedly, once the device has sent its information, it goes into a receive only mode. However, this is certainly n t an override of the type required. For example, the device would logically continue to determine its position, since the position of the device

-16-

Appl. No.   : **10/065,120**
Filed   : **September 18, 2002**

may be very necessary during a rescue operation. Clearly, therefore, claims like claim 1, which require preventing the unit from determining its position, are not met by Seiple in view of Ohyama. While it might be possible to use the teaching of Ohyama to put Seiple into some kind of sleep mode, this would destroy Seiple's functionality as <u>an emergency distress device</u>.

Similarly, the other claims such as claim 9, which require that the override control prevents the position module from reporting any information in any mode until manually deactivated, could not logically be provided by any fair combination of Seiple in view of Ohyama. Any attempt to modify Seiple in a way which would prevent it from reporting its information in any mode of operation, quite simply, prevents Seiple from being used as an emergency device. The emergency device must know its location and be able to transmit in an emergency at a moment's notice. It cannot be turned off. It cannot be put into a mode in which it cannot transmit its position "in any mode of operation". This quite simply would destroy the inherent functionality of Seiple. As such, it is respectfully suggested that this is an improper combination.

In addition, both Seiple and Ohyama are entirely different than a cellular phone. Therefore, like claims 3 and 10 which require a cellular or portable phone are even further patently distinct over Seiple in view of Ohyama.

<u>Yee does not teach preventing the position from being detected by the position sensing device.</u>

The 'Yee reference teaches a GPS receiver which allows you to set to determine its position. The rejection alleges that the override control prevents the position detector from "r porting information about its position". However, claim 3 does not use this language, but rather states that the position of the phone "cannot be automatically

-17-

Appl. No.   :   10/065,120
Filed   :   September 18, 2002

detected by said automatic position sensing device". There is the difference between

reporting and detecting, and in claim 3, the system prevents the automatic position

sensing device from even detecting its position. This is nowhere taught or suggested

by 'Yee. In fact, the cited areas of 'Yee show exactly that this is not done in 'Yee.

Column 2, lines 55-60 explain that the system determines its location, quite the

opposite of preventing the position from being automatically determined. The

remainder of that column admittedly talks about a sleep mode for certain devices but

teaches nothing about a sleep mode for the GPS. Column 11 lines 67 through column

12 line 12 simply explains that the position of the handset is sent via a GPS

communication. This teaches nothing about preventing it from being sent or even

preventing it from being obtained.

Claims 3-8 alternately stand rejected based on Krasner. Krasner admittedly

teaches that at certain times the GPS receiver can be deactivated based on a gating

signal. This is not done, however, to form a "privacy enhanced mode". As required by

claim 3. In fact, this is done to prevent gating periods from "becoming a large fraction

of the data bought.". Specifically, if the GPS in the handset is using too much of the

handsets processing power, then the system may turn off the GPS for a short period of

time. The GPS is turned back on, and in fact at all times the GPS device knows its

position approximately. Krasner does not teach this to be done for any mode; much

less a privacy enhanced mode; rather, Krasner teaches this to be an undesirable mode.

Finally, claims 3-8 stand rejected based on Herring. The rejection cites column

59 lines 17-19 which state that the GPS receiver can be deactivated once the asset is

found. However, this teaches nothing about a privacy enhanced mode which allows

calls to be automatically made at the position cannot be automatically detected.

-18-

Appl. No.   :   10/065,120
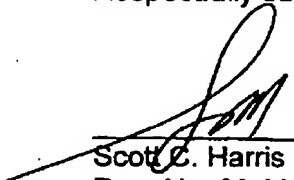Filed   :   September 18, 2002

'Herring teaches a system which tries to find a specified device such as an asset. Once the asset is found, clearly the GPS device could be turned off. In order to find the asset, the GPS device is turned on. However note that the only time the GPS device goes to sleep is <u>after the position information has been sent</u>. Therefore, clearly there is not any teaching to provide a system which provides a privacy enhanced mode of this type. In fact 'Herring only teaches turning off the device after its position has <u>already been reported</u> there can certainly be no privacy enhancement in such a situation.

For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance. A formal notice of allowance is hence respectfully requested.

Please charge any fees due in connection with this response to Deposit Account No. 50-1387.

Respectfully submitted,

Date: 7-22-03

Scott C. Harris
Reg. No. 32,030

OFFICIAL

RECEIVED
CENTRAL FAX CENTER

OCT 1 0 2003

Customer No. 23844
Scott C. Harris, Esq.
P.O. Box 927649
San Diego, CA 92192
Telephone: (619) 823-7778
Facsimile: (858) 678-5082

Attachment : Terminal Disclaimer based on US Patent number 6,473,031

-19-